

REMARKS

In the Official Action of June 10, 2003, the rejections made in the previous Official Action were withdrawn. However, claims 1-10 were rejected under 35 U.S.C. 103 as unpatentable over Gardner, *et al.* ("Gardner") in view of Dye and claims 11-20 were rejected over the combination of Gardner and Dye, and further in view of Arkans. These rejections are respectfully traversed for the following reason.

As stated in the second paragraph of MPEP §706.02(j), "[t]o establish a *prima facie* case of obviousness, three criteria must be met." First, the rejection must indicate some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be some expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. A review of the June 10, 2003 Action indicates that it fails to establish a proper *prima facie* showing of the obviousness of the differences between the claimed invention and the cited prior art references, alone or in the combinations asserted in the Action.

With regard to claim 1, it is respectfully urged that the §103 rejection was improper even before the claim was amended in Applicant's **Response to Official Action of October 29, 2002** and in this Response. The lack of a *prima facie* showing of the obviousness of the differences between that claim and the combination of Gardner and Dye is made apparent by reference to the recitation in claim 1 of the specific structure and materials comprising the claimed foot wrap and their functions (and as taught by *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), it is indeed appropriate to consider the functional recitations of a claim when assessing its patentability). Claim 1 recites "an interior elastic fabric sheet" and "an exterior fabric sheet . . . together forming a foot wrap wherein . . . said foot wrap encompasses an inflatable bladder . . . and the elasticity of said interior sheet [functions] to exert a lateral force on said exterior sheet such that said inflatable bladder is maintained substantially wrinkle-free when applied to a human foot." Neither of the cited references, alone or in combination, discloses or suggests such structure.

Near the top of page 2 of the Action, it is alleged that

"[t]he material from which the wrap is made is well within the realm of the artisan of ordinary skill. There are many different types of conventional permeable and impermeable materials that can be used. Gardner doesn't require any specific type of material for the wrap."

These allegations do not appear to be well founded. Contrary to the allegation in the third quoted sentence, Gardner does indeed require a specific material. Reference to the portion of that patent that was cited in making these allegations in the Action, specifically, the portion of the patent describing Figs. 4-6, makes it clear that for the embodiment shown in Fig. 4 of that reference,

Gardner teaches the use of "two like panels 20-21 of flexible material, such as PVC or polyurethane film" (col. 3, lines 35-37) which must, of course, be impermeable if they are to hold air as described in that patent. The embodiments shown in Figs. 5 and 6 of Gardner are described at col. 5, lines 25 *et seq.*, and it does not appear that Gardner includes any teaching as to the material comprising those two embodiments (in other words, Gardner does not teach that specific materials may be used or that a material of any type may be used for the embodiments shown in Figs. 5 and 6). So, contrary to the allegation in the Action that Gardner does not require a specific type of material, it appears that the teaching in the cited portion of Gardner as to the material from which the wrap is made is that the material must be a specific type of material, namely, an impermeable material. Although no such allegation is set out in the Action, the only other teaching as to the nature of the material that Applicant can find in Gardner is the teaching set out at col. 2, lines 31 *et seq.* to the effect that the inflatable bag 1 shown in that reference is secured over the instep of the foot 11 by a cloth sling as shown at reference numeral 4. However, Gardner does not appear to set out any teaching as to the nature of any specific "cloth" that is used for this purpose. For that matter, Gardner does not even teach that the cloth sling should be comprised of more than one layer of cloth, so it certainly cannot teach that the wrap should be comprised of more than one sheet, that one of the sheets is comprised of an elastic material, or that the elastic sheet should be the interior sheet, all as recited in claim 1.

Applicant certainly agrees with the second of the above-quoted sentences from the Action insofar as it suggests that there are many types of permeable and impermeable materials. Applicant does not, however, agree that all of the available permeable and impermeable materials can be used in a foot wrap. In fact, that second sentence illustrates the very point that Applicant intends to convey in the previous paragraph: there are many such materials, and when the cited art does not teach that the specific material recited in the claim should be used, it is clear that the art does not teach all the claimed elements such that no *prima facie* obviousness rejection has been established. Nor is the sentence in the Action to the effect that "[t]he material from which the wrap is made is well within the realm of the artisan of ordinary skill" a substitute for a teaching of the claimed material in the art:

"[a] statement that modifications of the prior to meet the claimed invention would have been 'well within the ordinary skill of the art' . . . because the references . . . teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references [citation omitted, underlining in original, bold emphasis added]."

MPEP §2143.01. In the absence of any teaching of such a modification of the cited references, Applicant calls upon the Examiner to make such evidence of record (in the form of an affidavit

as required by MPEP §2144.03) that such a modification of the cited art is within the Examiner's personal experience.

The lack of any teaching of the claimed material is not the only difference between the claimed invention and the cited art. Another difference between claim 1 and the combination of the Gardner and Dye references is that there is no teaching of how "the elasticity of [the] interior sheet" of the wrap functions "to exert a lateral force" on the exterior sheet. The allegation in the Action as to how Dye teaches an outer sheet that is stiffer and inelastic relative to the inner "film" so that the film conforms to the shape of the leg (in the middle of page 2 of the Action) does not constitute an allegation that the cited references disclose structure that functions to exert a lateral force. A teaching that it is desirable for one layer of material to "conform to the shape of the leg" as alleged in the Action is not a teaching that the inflatable bladder should be "maintained substantially wrinkle-free when applied to a human foot" as recited in claim 1, nor is it a teaching of structure that accomplishes this function. Further, by careful reference to the quoted disclosure of Dye, it can be seen that Dye teaches away from the claimed recitation: the Action correctly recites that Dye teaches that the inner film layer conforms to the shape of the leg while the outer, stiffer layer that "remains relatively flat upon inflation," but claim 1 recites structure that maintains the inflatable bladder, not the outer, stiffer layer as disclosed in Dye, wrinkle free.

Having established that the art does not teach at least these two elements of the claimed invention, in accordance with MPEP §706.02(j), the next inquiry is whether either reference provides some suggestion or motivation to modify the combined references in this manner. It is alleged at about the middle of page 2 of the Action that it would have been obvious

"to modify Gardner to use a specific type of material such as taught by Dye including a stiffer inelastic outermost film relative to the innermost layer so that the innermost layer conforms well to the shape of the leg while the former remains relatively flat upon inflation."

Whether the art includes such a suggestion or motivation as alleged in the Action appears to be irrelevant to the patentability of claim 1 because, as noted above, claim 1 does not recite that an inner layer should conform to the shape of the leg. Instead, claim 1 recites that the air bladder should remain substantially wrinkle-free when inflated.

Of course when there is no suggestion in the art to modify the references **in the manner claimed**, there can be no showing of the third element of a *prima facie* obviousness rejection, namely, an expectation of success. In the absence of a showing of (1) all the claimed elements in the cited art, (2) a suggestion in the art to modify the combined references in the manner claimed,

and (3) some expectation that such a modification can be made successfully, the §103 rejection of claim 1 is improper and should be withdrawn.

Claims 2 – 7, dependent on claim 1, are likewise allowable since they depend upon an allowable main claim. However, claims 2 and 3 recite that the inflatable bladder comprises at least a portion of the claimed interior sheet, and there is no allegation anywhere in the Action that the cited references teach such structure. Further, claims 5 – 7 all recite specifics of the structure of the seal and construction of the interior sheet and bladder, and just as with claims 2 and 3, there is no allegation anywhere in the Action that such structure is disclosed in the cited references. Reconsideration and withdrawal of the §103 rejection of claims 2 – 7 is therefore respectfully requested because the Action does not make out a proper *prima facie* showing of the obviousness of the differences between the claim and the combination of the cited references.

Claim 8 recites that when the wrap is secured to the foot using first and second tabs for wrapping around the arch and the heel, respectively, the inflatable bladder between interior and exterior fabric sheets “acts against the sole of the foot.” For the same reasons set out above with respect to claim 1, a §103 rejection of this claim is improper. Dye does not teach this structure or the positioning of the bladder so that it acts against the sole of the foot. As set out above, Gardner does not teach a bladder between interior and exterior sheets. Not only does the art not teach the claimed combination, but no attempt was made in the Action to identify the required suggestion in these references that they should be modified in the manner claimed. Similarly, the Action makes no mention of why one skilled in the art would expect to be successful in making such a combination. It is therefore apparent that a proper *prima facie* showing of the obviousness of the differences between claim 8 and the combination of Gardner and Dye has been established, that a §103 rejection of claim 8 is improper, and that this rejection should be withdrawn.

Claim 9, being dependent upon independent claim 8, is just as allowable as claim 8. Dependent claim 10 recites additional structure that is not disclosed in either Gardner or Dye, and the Action makes no allegation whatsoever that the structure called out in claim 10 would have been obvious to one of ordinary skill in the art at the time the invention was made such that it is very clear that a *prima facie* showing of the obviousness of the differences between claim 10 and the combination of Gardner and Dye was not established in the Action. Reconsideration and withdrawal of the rejection of claims 8-10 is respectfully requested.

Claims 11 and 12 are likewise dependent on independent claim 8 and, like claims 9 and 10, also allowable simply because they depend on an allowable independent claim. However, like claim 10, each of claims 11 and 12 adds subject matter that is not disclosed in the

combination of Dye and Gardner; nor does the structure recited in these claims appear to be disclosed in the cited Arkans patent. Reconsideration and withdrawal of the rejection of claims 11 and 12 over the combination of Dye, Gardner, and Arkans is respectfully requested.

The rejection of independent claim 13 over the combination of Gardner, Dye, and Arkans is also traversed for failure to make out a proper *prima facie* showing of the obviousness of the differences between the claimed invention and the combined references. Considering first whether the cited references teach all the elements of the claimed invention, a review of the three references reveals that they do not teach an inflatable bladder that acts "against the sole of the foot" as recited in the second element of claim 13. Dye does not teach this structure, nor does it disclose the positioning of the bladder so that it acts against the sole of the foot. As set out above, Gardner does not teach the specific material utilized, much less the use of a base material compatible with the hooks of a hook and loop-type fastener as recited in the first element of claim 1. To the contrary, Gardner describes the use of a pressure sensitive adhesive or a sock to hold that device in place on the foot. In apparent recognition of the lack of any such teaching in Gardner, it is suggested (at the top of page 3 of the Action) that it would have been obvious to "modify Gardner to provide the outer surface of the wrap with either hook or loop material as taught by Arkans." However, one of the reasons that the rejection of claim 13 is improper is that it does not identify where the required suggestion that the references should be combined is found in the cited prior art. In an apparent attempt to provide that required element of a proper *prima facie* showing of the obviousness of claim 13, it is alleged in the Action that Gardner should be modified to provide the outer surface with hook or loop material "so that the complementary fastener strap can be secured at any point on the outer surface of the wrap and to reduce the amount of materials used and save a manufacturing steps [sic, step] of adding a piece of material for the complementary fastener." Assuming for the sake of argument (and Applicant does not so admit) that the cited motivation for modifying Gardner in the manner urged in the Action would motivate one to make the claimed invention, the problem with the Action is that it merely alleges that one would be motivated to make such a modification. The Action does not allege, as required by MPEP §706.02(j), that this motivation is found in the prior art. In the absence of the disclosure of all of the claimed elements in the cited art and the absence of any suggestion **in the art** that the cited references should be modified in the manner claimed, it is clear that the third element required to make out a proper *prima facie* showing of the obviousness of the differences between the claim and the cited combination, a reasonable expectation that the modifications can be made successfully, certainly has not been set out in the Action. Because it seems that the Action fails to establish even one of the three required elements of a proper *prima*

facie showing of the obviousness of the differences between the claim and the cited combination, it is respectfully urged that the §103 rejection of claim 13 should be reconsidered and withdrawn.

Claims 14 - 16, dependent on independent claim 13, are almost identical in their subject matter to claims 9 - 11, which are addressed above. The same arguments as to the allowability of claims 9 - 11 are therefore re-asserted here in their entirety with respect to claims 14 - 16, and it is respectfully requested that the §103 rejection of claims 14 - 16 be reconsidered and withdrawn.

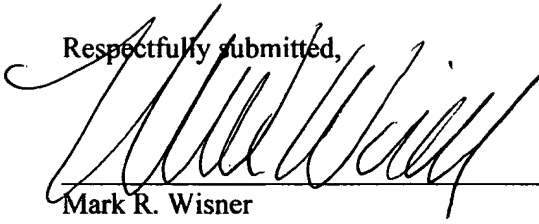
Independent claim 17 is similar in content to independent claim 8, and so the same arguments as to the allowability of claim 8 are re-asserted here in their entirety with respect to claim 17. Claim 17 includes additional structure beyond that recited in claim 8 that is not disclosed by the combination of Gardner, Dye, and Arkans. Specifically, claim 17 recites the structural relationship between the tabs and the main portion of the foot wrap. This structure is not disclosed in Arkans, nor is it disclosed in the combination of Arkans with Gardner and Dye, such that the rejection of claim 17 fails to establish a proper *prima facie* showing of the obviousness of the differences between the claim and the combination of the cited references. For these reasons, it is respectfully requested that the §103 rejection of claim 17 be reconsidered and withdrawn.

The Action makes no mention of claims 18 or 19, dependent upon independent claim 17, and it therefore makes no attempt whatsoever to apply the cited references to these claims. Consequently, no *prima facie* showing of the obviousness of the differences between claims 18 and 19 and the combination of the cited references has been established and it is therefore requested that the rejection be withdrawn.

The same remarks set out in the preceding paragraphs are equally applicable to the §103 rejection of claim 20 and are re-asserted with respect to claim 20 as if fully set forth in this paragraph. Reconsideration and withdrawal of the rejection of claim 20 for this same reason is respectfully requested.

Reconsideration and withdrawal of each of the rejections, entry of the above amended claims, consideration of the remarks set out herein, allowance of the claims, and passage of the application to issuance are all respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark R. Wisner', written over a horizontal line.

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